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STMICROELECTRONICS, INC.  
MAIL STATION 2346  
1310 ELECTRONICS DRIVE  
CARROLLTON TX 75006

**MAILED**

**JUN 19 2009**

**OFFICE OF PETITIONS**

In re Application :  
Phillips et al. :  
Application No. 09/927,426 :  
Filed: August 10, 2001 : DECISION ON PETITION  
Attorney Docket No. 95-L-024C3 RE :  
(1678-41) :

This is a decision on petition filed under 37 CFR 1.47 on February 27, 2009, and supplemented on March 9, 2009, which is taken under 37 CFR 1.183,<sup>1</sup> requesting suspension or waiver of the regulations (presumably 37 CFR 1.172) that require the inventors to sign any supplemental declaration in a broadening reissue application.

Petitioner requests waiver of the rule (presumably §1.172) that requires that the inventor sign any supplemental declaration in a broadening reissue application.

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<sup>1</sup>37 CFR 1.47 only applies where, in the first instance, the signature of an originally named, or to be added, inventor can not be obtained. As all inventors executed an original reissue declaration and thus "made" the application, 37 CFR 1.47 does not apply in this case. See 37 CFR 1.47; MPEP 201.03. Rather, the remedy lies under 37 CFR 1.183, when a required supplemental declaration is not executed in whole or in part by one or more previously signing inventors. See MPEP 603. If a joint inventor refuses, or cannot be found or reached, to sign a supplemental oath/declaration, a supplemental oath/declaration listing all the inventors, and signed by all the available inventors may be filed, provided it is accompanied by a grantable petition under 37 CFR 1.183 along with the petition fee, requesting waiver of the signature requirement of the nonsigning inventor. MPEP 1414.01.

The petition is dismissed.

The Office is in receipt of \$200.00 petition fee. However since this petition is properly treated under 37 CFR 1.183, pursuant to petitioner's request deposit account 07-1897 will be charged the \$200.00 difference towards the \$400.00 petition fee.

### **BACKGROUND**

1. U.S. Patent No. 5,936,451 issued to William Phillips, Mario Paparo and Piero Capocelli on August 10, 1999.

2. A broadening reissue application (the present application) was filed on August 10, 2001, and it was assigned application number 09/927,426.

3. During the prosecution of the application, a supplemental declaration directed to errors in the original patent which were corrected in the reissue application after the signing of the original reissue declaration under 37 CFR 1.175(b)(1) was required by the examiner in the Office communication of August 21, 2006.

4. On November 2, 2006, applicant filed the present petition under 37 CFR 1.47 properly treated under 37 CFR 1.183 requesting suspension or waiver of the "regulations pertaining to the filing of a Supplemental Declaration under 37 C.F.R. § 1.175" that require a supplemental reissue declaration to be signed by the inventor.

5. The petition is accompanied by a "Supplemental Reissue Declaration," signed by inventors Paparo and Capocelli. It is for this supplemental declaration that the petition requests acceptance, via suspension or waiver of the regulations.

### **DECISION**

35 U.S.C. 251, which is directed to reissue, does not address the signature requirements of a declaration in reissue. 37 CFR 1.172 requires that a reissue declaration be made (and signed) by the

inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. 37 CFR § 1.175(b)(1), requires that:

"For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant."

37 CFR 1.175(b)(1), taken in conjunction with § 1.172, requires a supplemental declaration to be signed by all inventors. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of the inventor(s).

37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested a waiver of the requirement that the 37 CFR 1.175(b)(1) supplemental declaration be signed by all of the inventor.

In the present petition, the supplemental declaration fails to include the citizenship of non-signing inventor Phillips. On renewed petition, applicants must submit a supplemental declaration executed by the signing inventors and provide the citizenship of inventor Phillips pursuant to 37 CFR 1.175 and 1.63 (a)(3). In addition, unless otherwise provided in a signed supplemental application data sheet, applicants must also include, in the supplemental declaration, the mailing address of inventor Phillips pursuant to 37 CFR 1.63 (c)(1).

#### **CONCLUSION**

Since the showing as to extraordinary circumstances is incomplete, § 1.183 cannot be invoked in order to waive § 1.172. Accordingly, this petition is being dismissed.

Any request for reconsideration should be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely. 37 CFR 1.181(f). This time period may **not** be extended

Further correspondence with respect to this matter should be addressed as follows:

By delivery service: U.S. Patent and Trademark Office  
(FedEx, UPS, DHL, etc.) Customer Service Window,  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration